

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to the claims because claim 1 includes reference characters not enclosed within parenthesis. In response, claim 1 has been amended to remove such reference characters. The Examiner also objects to claim 11 because the phrase "which the snare where is inserted" should be --which the snare is inserted--. In response, claim 11 has been amended as suggested by the Examiner. Accordingly, it is respectfully requested that the objection to the claims be withdrawn.

In the Official Action, the Examiner rejects claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,968,056 to Chu (hereinafter "Chu"). Additionally, the Examiner rejects claim 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,068,603 to Suzuki (hereinafter "Suzuki"). Furthermore, the Examiner rejects claims 2-10 under 35 U.S.C. § 103(a) as being unpatentable over Chu.<sup>1</sup> Still Further, the Examiner rejects claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Chu in view of Suzuki.

In response independent claims 1 and 2 have been amended to clarify their distinguishing features and to improve their form and readability. The dependent claims have also been amended, where necessary, to be consistent with amended claim 1 and also to improve their form and readability. The amendment to the claims is fully supported in the original disclosure. Thus, no new matter has been entered into the original disclosure by way of the present amendment to the claims.

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<sup>1</sup> Although claim 9 is not indicated as being rejected in paragraph 8 of the Official Action, the same appears to be treated as being rejected in subsequent portions of the Official Action (at page 6 thereof).

Specifically, claim 1 has been amended to recite:

“a substantially cylindrical cap including a cylindrical wall, and a holding mechanism which holds a distal end portion of a snare wire in a loop form, in an inner portion of the cylindrical wall; and an attachment portion which attaches the cap to an end portion of the endoscope,

wherein the holding mechanism has a plurality of engagement pieces and a plurality of corresponding portions which hold the distal end portion of the snare wire between the engagement piece and the corresponding portion, said plurality of engagement pieces being inwardly protruding from the cylindrical wall and being respectively distanced from each other in a circumferential direction of the circular end portion.”

Independent claim 12 has been amended to recite:

“a substantially cylindrical cap; an attachment portion which attaches the cap to an end portion of the endoscope; and a flexible tube including a distal end portion having an end opening communicating with an inner side of the cap, the flexible tube being arranged outside an insertion portion of the endoscope when the cap is attached to the endoscope and used to insert a snare sheath of a high-frequency snare therein, an end portion of a snare wire of the high-frequency snare inserted in the cap through the flexible tube being expanded and arranged in the cap, wherein a fixture for fixing the snare sheath of the high-frequency snare to prevent the snare sheath to move in an axial direction of the snare sheath against the flexible tube, so as to be capable of being released is provided to a proximal end portion of the flexible tube.”

In claim 1, as amended, a portion of the features recited in claim 3 has been incorporated therein. That is, the recitation “said plurality of engagement pieces being inwardly protruding from the cylindrical wall” has been added to claim 1 to clearly distinguish the mucosa excising device of claim 1 from that which is disclosed by Chu.

In the mucosa excising device of claim 1, the plurality of engagement pieces are inwardly protruding from the cylindrical wall and respectively distanced from each other in a circumferential direction of the circular end portion. Thus, the distal end portion of the snare wire may be arranged in a substantially circular shape along an entire circular end portion of a

cylindrical wall, so that the looped distal end portion of the snare wire may be also expanded in a substantially circular shape. Accordingly, the circular end portion of the snare wire may catch the living tissue (e.g., excision part A2) of a relatively large diameter therein in an easy and accurate manner.

The engagement portions 68a-c, 68a'-c' disclosed in Chu are the notches formed at the end surface of the distal end (10) of the housing. The looped distal end portion of the snare wire is partially engaged with the notches. Thus, they are different from the engagement pieces recited in claim 1 in their structure, and also in function since they do not have the function of "holding the distal end portion of the snare wire between the engagement piece and the corresponding portion".

The engagement portion 90 of Chu is a catch. Although it is not possible to understand what structure the catch has and how the catch catches the snare from the Chu disclosure, the Applicant respectfully submits that Chu at least fails to disclose the engagement piece recited in claim 1.

Furthermore, Chu does not disclose the structures recited in dependent claims 2 to 11. For example, the Applicant respectfully submits that the inner flange recited in claim 3 is different from the distal end 10 disclosed in Chu. In Chu, although the arcuate piece on which the snare ports (85a to 85c) are formed may be regarded as an inner flange, the ports formed on the piece alone cannot "hold a distal end portion of a snare wire in a loop form."

Claims 11 and 12 have been amended to further clarify the fixture recited therein. The Applicant respectfully submits that Suzuki does not disclose or suggest "a fixture for fixing the snare sheath to prevent the snare sheath from moving in an axial direction of the snare sheath against the flexible tube."

The stop ring indicated by the Examiner as the fixing means (23) is intended to prevent the rearward movement of the connection pipe (15) and the snare wire (14), and it does not prevent the forward movement of the connection pipe (15) and the snare wire (14).

With regard to the rejections of claims 1 and 12 under 35 U.S.C. § 102(b), a mucosa excising device having the features discussed above and as recited in independent claims 1 and 12, is nowhere disclosed in either Chu or Suzuki. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>2</sup> independent claims 1 and 12 are not anticipated by either Chu or Suzuki. Accordingly, independent claims 1 and 12 patentably distinguish over both Chu and Suzuki and are allowable. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 1 and 12 under 35 U.S.C. § 102(b).

With regard to the rejections of claim 2-11 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 2-11 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 2-11 under 35 U.S.C. § 103(a).

Furthermore, new claims 13-17 have been added to further define the patentable invention. New claims 13-17 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 13-17. The Applicant respectfully submits that new claims 13-16 are at least allowable as depending upon an allowable base claim. Furthermore, the Applicant respectfully submits that the features of new dependent claims 13-16 are not disclosed or suggested either Chu or Suzuki. Further, the fixture defined in

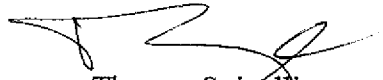
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<sup>2</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

claim 16 is different from the stop ring in the position where it is arranged, and the way it is fixed. The Applicant further submits that independent claim 17 patentably distinguishes over the prior art and is allowable for at least the reason that Chu fails to disclose the hold state of a snare wire recited in new independent claim 17.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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